

PTO/SB/17 (12-04v2)

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# FEE TRANSMITTAL

## For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250.00

**Complete if Known**

Application Number	10/663,931
Filing Date	09/16/2003
First Named Inventor	John Higgins
Examiner Name	Bui, Luan Kim
Art Unit	3728
Attorney Docket No.	03-029-JH

**METHOD OF PAYMENT** (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 12-0115 Deposit Account Name: Lambert & Associates

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>	
- 20 or HP = _____	x _____	= _____		<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>

HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 3 or HP = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

**4. OTHER FEE(S)**

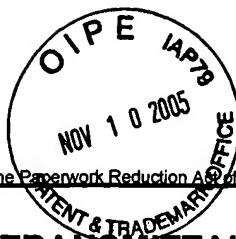
Non-English Specification, \$130 fee (no small entity discount)

**Fees Paid (\$)**☒ Other (e.g., late filing surcharge): Filing of Appeal Brief under 37 CFR 41.20(b)(2)**SUBMITTED BY**

Signature	<u>Patrick D. Archibald</u>	Registration No. (Attorney/Agent) 52,464	Telephone 617-720-0091
Name (Print/Type)	Patrick D. Archibald	Date 11/08/2005	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/21 (09-04)

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 14

Application Number	10/663,931
Filing Date	09/16/2003
First Named Inventor	John Higgins
Art Unit	3728
Examiner Name	Bui, Luan Kim
Attorney Docket Number	03-029-JH

**ENCLOSURES (Check all that apply)**

- |   |  |  |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts<br>under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><br><input type="checkbox"/> Appeal Communication to Board<br>of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify<br>below):<br>Return Receipt Postcard |
|---|--|--|

**Remarks**

The Appeal communication is an Appeal Brief.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Lambert & Associates		
Signature			
Printed name	Patrick D. Archibald		
Date	11/08/2005	Reg. No.	52,464

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name Patrick D. Archibald

Date 11/08/2005

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Apl. No. 03/663,931

Applicant John Higgins

Filed : September 16, 2003

TC/A.U. : 3728

Examiner : Bui, Luan Kim

Docket No. : 03-029-JH

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### APPEAL BRIEF

Sir:

Please find enclosed an Appeal Brief in support of the above-referenced application.

11/14/2005 WARDELRI 00000049 120115 10663931  
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## REAL PARTY IN INTEREST

The real party in interest is Mr. John Higgins, as inventor and applicant.

## RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## STATUS OF CLAIMS

Claims 1, 4, 8 and 12-17 are pending in the application. Claims 1, 4, 8 and 12-17 have been finally rejected and are the subject of this appeal. All other claims have been cancelled.

## STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

## SUMMARY OF CLAIMED SUBJECT MATTER

### **Claim 1**

Claim 1 defines a wallet pill card that first includes a card portion and a cavity element. The card has top and bottom surfaces that define dimensions similar to or smaller than that of a standard credit card. Page 4, lines 19-22; Page 6, lines 7-11, Fig. 1-5, Ref. 1. The top and bottom surfaces refer to the upper and lower areas of the card without regard to the front or back faces of the card portion. In other words, the top and bottom surfaces are directed toward the perimeter edges of the card. The card is the only portion that has

the dimensions of a credit card, and is therefore easily inserted into a credit card pocket found within a wallet. Page 4, lines 22-23. The sealed cavity element is located on the top portion of the card element. Page 6, lines 8-9, lines 10-13. This structure allows for the key advantage of the wallet pill card, namely that the sealed cavity resides within the space created in a wallet when folded over. Page 6, lines 17-24. This creates a protective space around the medicine that is being held by the wallet pill card.

### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The examiner has rejected claims 1, 4 and 8 under 35 U.S.C. 102(b) as being anticipated by Bartell, et al. U.S. Patent No. 4,889,236 (hereinafter "Bartell"). The examiner is of the opinion that Bartell discloses a rigid credit card style pill card having the peripheral dimension of a credit card/wallet pill card comprising all of the elements of applicant's invention. With regard to claims 4 and 8, the examiner is of the opinion that Bartell is inherently capable of containing oral tablets, or a tube of medicament.

The examiner has rejected claims 12-17 under 35 U.S.C. 103(a) as being unpatentable over Bartell in view of Mattis, et al. U.S. Patent Application Publication No. 2002/0066690 (hereinafter "Mattis") and Robertson, U.S. Patent No. 6,516,950 (hereinafter "Robertson"). The examiner cites to In re Rose, 105 USPQ 237 (CCPA 1955) to aid in the determination that it would have been obvious to modify the card of Bartell to the same thickness of a credit card because a change in size is generally recognized as being within the level of ordinary skill in the art.

## ARGUMENT

### **Rejection Under 35 U.S.C. 102(b)**

#### **Claim 1**

As noted by the examiner, 35 U.S.C. 102(b) states that:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Therefore, applicant's invention will be unpatentable only if each and every element claimed in it is disclosed by the patent granted to Bartell.

With regard to claim 1, it is important to properly explain the construction of the Bartell pill card, as disclosed in its specification. Bartell discloses a pill card that comprises three portions, an upper portion (100), a middle portion (200) and a bottom portion (400). These three portions comprise dimensions substantially similar to a credit card and are secured together at their faces to form the wallet pill card (10). The top portion (100) includes a top surface (120) and a bottom surface (130). These *surfaces* are properly seen as the flat front and back *faces* of the upper portion (100) and both are laminated. Additionally, the upper portion (100) is "punched with a plurality of apertures 110."

The first distinction of importance is that the card (10) of Bartell is not the same as applicant's card portion. The card (10) of Bartell references the entire wallet pill card generally, while applicant's card portion is disclosed as the lower portion of the device having dimensions similar to a standard credit card. Applicant's card portion is a single,

solid piece of material, while the card (10) of Bartell is limited to a card with dimensions similar to a credit card and includes pockets for holding pills. Bartell, col. 2, lines 31-37. Although both devices include the term "card," the elements are in fact very distinct, having little in common with each other structurally. This significant difference is sufficient in and of itself to overcome a rejection based on anticipation.

The examiner has also argued that Bartell discloses a wallet pill card comprising a card with top and bottom surfaces and at least one sealed cavity located on the top surface. Final Office Action, paragraph 2. However, as previously noted, the top surface (120) of Bartell refers to the front *face* of the card, not the upper perimeter portion of the card. Although the card of Bartell will inherently include an upper perimeter portion, this upper perimeter portion of the card has not been designated as the location of the single sealed cavity. On the contrary, the only reference to this section of Bartell's card reveals this portion as the location of calendar indicia 20, as shown in Bartell Figures 1 and 4. The sealed cavity of applicant's pill card is "located *on* the top surface at the perimeter edge of said card." Applicant, claim 1 (emphasis added). Accordingly, Bartell does not disclose a sealed cavity located on the top surface at the perimeter edge of the card, as claimed by applicant.

Additionally, and as noted above, Bartell discloses only a "plurality of apertures (110)", not *at least one* sealed cavity as alleged by the examiner. This distinction is important, for it would be a very different matter if Bartell had disclosed, or claimed, a single sealed cavity. Bartell discloses, and claims, only a plurality of spaced apart apertures, Bartell, col. 4, line 37, where applicant's pill card includes the limitation of a

single sealed cavity. Therefore, Bartell does not disclose a wallet pill card that can comprise a single sealed cavity, while applicant's invention may be so limited.

#### Claims 4 and 8

The Examiner has stated that Bartell is "inherently capable to contain oral medical tablets or a tube of medicament." With respect to oral medical tablets, Applicant acknowledges that this is so. As a result, Applicant's response to the rejection of claim 4 is dependent upon the arguments made in opposition to claim 1, from which claim 4 depends.

With respect to claim 8, Applicant argues that the device of Bartell is in no way capable, inherently or otherwise, to contain a tube of medicament. The ordinary meaning of a "tube of medicament" indicates that at the least, a tube is involved. The tripartite structure of Bartell, its plurality of apertures, and size limitation prevent it from being capable of holding a tube of medicament. Bartell could be modified to hold tubes, but based on its structure, the device would no longer serve its intended purpose. This amount of modification would be beyond what is necessary to support a novelty or obviousness rejection. Accordingly, the rejection of claim 8 should be reversed.

#### Rejection Under 35 U.S.C. 103(a)

As noted by the examiner, 35 U.S.C. 103(a) states that:

a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.



Therefore, Applicant's invention will be unpatentable if the differences between it and the combined knowledge disclosed in the patents granted to Bartell in view of Mattis and Robertson are such that applicant's invention would have been obvious.

#### Claim 12

The Examiner argues that Mattis and Robertson teach the modification of the card of Bartell to the same thickness as a credit card. However, this argument must fail because of the fact introduced above, regarding the difference in the "card" of Bartell and the card portion of Applicant's invention. Bartell's card includes apertures that house pills, and as such the minimum dimensions of Bartell's device will be limited to the dimensions of the pills. It is common knowledge that most pills have widths greater than standard credit card dimensions. As such, it is not the card of Bartell that needs to be modified. Therefore, this proposed modification does nothing to render Applicant's invention obvious.

Additionally, the Examiner cites to *In re Rose*, 105 USPQ 237 (CCPA 1955) for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art. This proposition is true for the general case, but the present case involves a situation where a change in size constitutes a critical claim limitation. It is not enough to merely recite the general proposition. Changing the size of the device of Bartell would likely render it incapable of holding the medication for which it is designed, thereby rendering it inoperable. Such a change or modification would not be attempted by one of ordinary skill if the result would be a removal of all utility of the device. Therefore, a change in the size of Bartell's card achieves nothing in relation to

Applicant's device. Bartell fails to anticipate in the first instance, and a change in size does nothing more than result in a smaller non-anticipating device.

#### Claims 13-16

Applicant acknowledges that Robertson discloses the inclusion of indicia, and that the indicia may include information relating to the enclosed pills, or a label that provides important personal information. However, combining that information with Bartell does nothing to render Applicant's invention obvious. Preliminarily, as argued above, Bartell does not disclose Applicant's device, therefore addition elements to it will not result in obviousness determinations for subsequent claims.

Additionally, there is nowhere to place the indicia disclosed in Robertson on Bartell, other than the very top perimeter, as seen in Fig. 1 of Bartell. Therefore, a person of ordinary skill would not attempt to combine the indicia of Robertson on the very small area allowed by Bartell's devices. As previously noted, Bartell already discloses that indicia may be included at the top perimeter edge, and that indicia is to be references to abbreviated days of the week, as shown in Fig. 1 and 3. This is additional evidence that the information disclosed by Robertson could not physically exist upon the device of Bartell.

Also, contrary to the Examiner's assertion, Robertson discloses nothing with regard to advertisements, and is limited to medical information. Robertson actually would preclude the inclusion of advertisements, as the purpose of the device is to assist in medical emergencies, and advertisements would inhibit this function. Because there is no

mention of advertisements anywhere within the patent, the Examiner can not find support in Robertson for the inclusion of advertisements on the device of Bartell.

#### Claim 17

The Examiner's rejection of claim 17 almost appears disingenuous on its face. Robertson does disclose a type of resealing mechanism. However, the resealing mechanism of Robertson is nothing more than a hinged cover that closes over a small cavity. Robertson, col. 6, lines 60-64. There is little to similarity between the two resealing mechanisms.

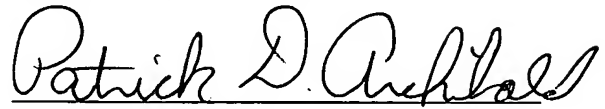
More telling is the fact that a resealing mechanism would be absurd if combined with Bartell. Bartell's entire structure is predicated upon its tripartite layers and plurality of apertures. Similar to pill holders well known in the art, the tripartite structure allows for a foil layer to be exploited during removal of a single pill, while retaining the sterility of the remaining, separately housed tablets. It would make no sense, and would require undue experimentation to attempt to modify the device of Bartlett to include resealable cavities. And as was also state previously, the end result would be nothing more than a plurality of resealable cavities, not a single cavity that is exposed to reside within the open space of a wallet. The device of Bartell is a blister style pill holder, Bartell, col. 1, line 5, and as such the addition of a resealing mechanism would likely remove any utility the device might originally have.

For the reasons advanced above, Applicant respectfully contends that each pending Claim is patentable. Therefore, reversal of all rejections is courteously solicited.

11/08/2005  
Date

Patrick D. Archibald  
Lambert & Associates  
92 State Street  
Boston, MA 02109  
Tel. (617) 720-0091

Respectfully Submitted,

A handwritten signature in cursive script, reading "Patrick D. Archibald". The signature is written in dark ink and is positioned above a horizontal line.

Patrick D. Archibald  
Attorney for Applicant  
Reg. No. 52,464

## CLAIMS APPENDIX

1. A personal wallet pill card comprising:

a card having a top surface and a bottom surface including at least one sealed cavity located on the top surface at the perimeter edge of said card.

2. (canceled)

3. (canceled)

4. The personal wallet pill card of claim 1 wherein:

said sealed cavity is designed to contain oral medical tablets.

5-7 (canceled)

8. The personal wallet pill card of claim 1 wherein:

said sealed cavity is designed to contain a tube of medicament.

9-11 (canceled)

12. The personal wallet pill card of claim 1 wherein:

said card has a thickness thinner or the same thickness as a credit card.

13. The personal wallet pill card of claim 12 wherein:

said card has writing on the top surface.

14. The personal wallet pill card of claim 13 wherein:

said writing is instructions for ingesting aspirin during a heart attack.

15. The personal wallet pill card of claim 13 wherein:

said writing is an advertisement.

16. The personal wallet pill card of claim 12 wherein:

said card has writing on the bottom surface.

17. The personal wallet pill card of claim 1 further including:

a cavity resealing mechanism for multiple uses.

## EVIDENCE APPENDIX

The following is the evidence (patents and patent application) submitted by the examiner and relied upon by appellant in the appeal.

4,889,236	Bartell, et al.	12-1989
6,516,950	Robertson	2-2003
US2002/0066690	Mattis, et al.	6-2002

## RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board in any proceeding as noted in the section titled: **RELATED APPEALS AND INTERFERENCES**.